

REMARKS/ARGUMENTS

The Office Action of September 7, 2010 has been carefully reviewed and these remarks are responsive thereto. Claims 1-4, 8, 9, 16 22, and 26- 28 have been amended, and claims 25, 29, and 33 have been canceled without prejudice or disclaimer. No new matter has been added. Claims 1-6, 8-16, 18-20, 22, 24, 26-28, 30-32, 34-36, and 38-40 thus remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

Rejections Under 35 U.S.C. § 103

The action applies the following references under 35 U.S.C. 103(a): U.S. Pat. No. 5,410,326, hereinafter Goldstein; U.S. Pat. No. 5,047,858, hereinafter Aimonoya; U.S. Pat. No. 5,467,144, hereinafter Saeger; U.S. Pat. No. 3,953,666, hereinafter Justice; U.S. Pat. No. 3,256,386, hereinafter Morchand; U.S. Pat. No. 5,477,262, hereinafter Banker; and U.S. Pat. No. 5,539,871, hereinafter Gibson. Claims 1-6, 24-26, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the following combinations of references:¹

- Goldstein, in view of Aimonoya, and Saeger;
- Goldstein, in view of Justice; and
- Goldstein, in view of Morchand.

Claims 22, 33 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the following combinations of references:

- Banker, in view of Aimonoya, and Saeger.
- Banker, in view of Justice.
- Banker, in view of Morchand.

Claims 8-16, 18-20, 29 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the following combinations of references:

- Banker, in view of Gibson, Aimonoya, and Saeger.
- Banker in view of Gibson and Justice.
- Banker in view of Gibson, and Morchand.

¹ The Action indicates that claim 28 is rejected on the same combinations of references, but provides no basis for the rejection.

Applicant respectfully traverses these rejections.

Independent claims 1, 8, and 22 have been amended to substantially incorporate the features of claims 25, 29, and 33 respectively. Independent claims 1 and 8, as amended, recite the feature of “wherein the single video clip is repositioned from one of the different portions of the split screen to a position in the menu”; independent claim 22, as amended, recites the feature of “wherein ... a single video clip of the multiple video clips is repositioned from one of the different portions of the split screen to a position in the one of the menus”; and independent claim 24, unamended, recites the feature of “displaying ... a single video clip of the multiple video clips repositioned from one of the different portions of the split screen to a position in the electronic program guide.” The Office Action concedes that Goldstein (with respect to claims 1 and 24), Banker (with respect to claim 22), and Banker combined with Gibson (with respect to claim 8) fail to disclose these features. Instead, the Action points to Aimonoya combined with Seager, Justice, or alternatively, Morchand for these features.

Aimonoya Combined With Seager

The Office Action, on pages 3-5, 13-14, 16-17, and 21, alleges that the above identified features of independent claims 1, 8, 22 and 24 are disclosed by a combination of Aimonoya and Seager. With respect to claim 1, the action appears to assert that Aimonoya discloses the claim feature of “video channel including a split screen with multiple video clips,” and that Seager discloses receiving the video channel and displaying only one of the video clips, “wherein the single video clip is repositioned from one of the different portions of the split screen to a position in the menu” as recited in claim 1. See action page 3-4 and 5. Applicant respectfully disagrees.

Aimonoya merely discloses reducing a plurality of images to one-quarter size sub-frame images, and combining the sub-frame images to be displayed on a single display. See Aimonoya, Abstract, Fig. 1, col. 7 lines 41-43. From the Action’s discussion of Aimonoya saving bandwidth by generating the split screen (See Action, page 3), the Action appears to be alleging that Aimonoya transmits the generated split screen as the claimed “video channel” such that it may be received by the claimed “tuner” which is allegedly disclosed in Goldstein. However, as clearly shown in Aimonoya, the split screen is directly output to drive a NTSC

monochrome TV for the purpose of displaying four sub-frames. See Aimonoya, Fig. 1, col. 1 lines 52-61 and col. 7 lines 41-46. Aimonoya has no discussion of saving bandwidth as asserted by the action, and indeed, has no discussion of transmission of a “video channel” in any manner. Thus, to the extent that Aimonoya discloses the generation of a split screen display, Aimonoya is irrelevant to claim 1 which recites “a tuner configured to receive a video channel including a split screen.”

Even if Aimonoya were to disclose the claim 1 “video channel”, which Applicant does not concede, Saeger fails to disclose the features for which it is cited. For the claim 1 feature of “wherein the single video clip is repositioned,” the Action points to Seager’s disclosure of how to reposition videos in a picture-in-picture format. However, the Action fails to recognize that these repositioned videos in Saeger were complete frame videos separately received on different channels, and that the object of Seager is to combine these separately received videos together into a composite display. Saeger does not teach or suggest: 1) receiving a single video channel which already includes a split screen video as allegedly disclosed in Aimonoya; and then 2) repositioning one video clip of multiple video clip of an already combined split screen video into a new position.

Stated differently, both Aimonoya and Saeger teach the opposite process with a different result than that of claim 1. Both Aimonoya and Saeger start with videos which are formatted separately as full frame videos and which are then combined to display a single split screen frame, as opposed to starting with an already combined split screen frame, and repositioning one of the video clips “from one of the different portions of the split screen” as recited in claim 1. Aimonoya and Saeger disclose similar processes to each other with the only difference being that the original full format videos in Aimonoya are received directly from image pickup devices, while in Saeger the full format videos are received on separate video signals.

Accordingly, Aimonoya and Saeger do not teach or suggest at least the claim 1 feature (and similar claims 8, 22, and 24 features) of “wherein the single video clip is repositioned from one of the different portions of the split screen to a position in the menu.” The Office Action concedes that Goldstein (with respect to claims 1 and 24), Banker (with respect to claim 22), and Banker combined with Gibson (with respect to claim 8) fail to disclose these features.

Accordingly, claims 1 and 24 are allowable over the combination of Goldstein, Aimonoya and Saeger; claim 22 is allowable over the combination of Banker, Aimonoya, and Saeger; and claim 8 is allowable over the combination of Banker, Gibson, Aimonoya, and Saeger.

Justice

The Office Action, on pages 6-8, 23-24, 26, and 31 alleges that the features of independent claims 1, 8, 22 and 24 discussed above with respect to Aimonoya, and Saeger are also disclosed in Justice. Specifically, with respect to claims 1 and 25 (now canceled) the Action asserts on pages 6-8 that:

Justice discloses a video reception terminal (Fig. 1 and 3) which will receive a video channel consisting of a split screen with multiple video clips positioned in different portions of the split screen (Fig. 1; column 1, lines 45-60) and which will only display a single one of the video clips on the screen with the single video clip repositioned from one of the different portions of the split screen to [a] different position (column 5, lines 30-52) which would save bandwidth and allow multiple videos over a single channel utilizing an existing method in a known manner.

...

As to claim 25, Goldstein and Justice disclose the terminal is configured to reposition the single video clip from one of the different portions of the split screen to a position in the electronic program guide (see Justice at column 5 lines 30-52).

Applicant respectfully disagrees. Justice discloses an analog television system used in an educational system for transmitting and receiving a signal having four different pictures presented in four quadrants of a television receiving tube. See Justice, Abstract. The four pictures are presented together as four possible answers to a multiple choice question in which a pupil may select one of the pictures as the correct answer. See Justice, col. 1 lines 7-42. Based on the pupil's selection, the selected quadrant may be centered and amplified to fit the entire television receiving tube face. See Justice, col. 2 lines 6-11.

Justice does not teach or suggest that the selected quadrant can be "repositioned from one of the different portions of the split screen to a position in the menu" as recited in claim 1. In contradistinction, Justice merely discloses how to manipulate analog control signals which drive a cathode ray tube of a television to center and amplify the selected quadrant to fit the entire area

of cathode ray tube's display. See Justice, col. 3 line 9 to col. 4 line 59. The manner in which Justice drives the cathode ray tube could not be applied to reposition a quadrant to a position in a menu as recited in independent claim 1, or as similarly recited in independent claims 8, 22, and 24. The Office Action concedes that Goldstein (with respect to claims 1 and 24), Banker (with respect to claim 22), and Banker combined with Gibson (with respect to claim 8) fail to disclose this feature. Accordingly, claims 1 and 24 are allowable over the combination of Goldstein and Justice; claim 22 is allowable over the combination of Banker and Justice; and claim 8 is allowable over the combination of Banker, Gibson, and Justice.

Morchand

The Office Action, on pages 9-11, 33, 36-37, 40, alleges that the features of independent claims 1, 8, 22 and 24 discussed above with respect to Aimonoya, and Saeger, and with respect to Justice, are also disclosed in Morchand. Specifically, respect to claims 1 and 25 (now canceled) the Action asserts on pages 9-11 that:

Morchand discloses a video reception terminal (Fig. 1 and 2) which will receive a video channel consisting of a split screen with multiple video clips positioned in different portions of the split screen (Figs. 1 and 2; column 2, line[s] 2-32) and which will only display a single one of the video clips on the screen with the single video clip repositioned from one of the different portions of the split screen to a different position (column 4, lines 53-74) which would save bandwidth and allow multiple videos over a single channel utilizing an existing method in a known manner (column 2, line 2-32).

...

As to claim 25, Goldstein and Morchand disclose the terminal is configured to reposition the single video clip from one of the different portions of the split screen to a position in the electronic program guide (see Morchand at column 4 lines 53-74).

Applicant respectfully disagrees. Like Justice, Morchand discloses an analog television system used in an educational system for transmitting and receiving a signal having four different pictures presented in four quadrants of a television receiving tube. See Morchand, Fig. 2, col. 1 lines 14-17 and 45-52, col. 4 lines 32-47. The four pictures are presented together as four possible answers to a multiple choice question in which a pupil may select one of the pictures as the correct answer. See Morchand, col. 5 lines 3-25. Based on the pupil's selection,

the non-selected quadrants are blanked out, and the remaining quadrants are displayed in their original positions on the cathode ray tube of the television. See Morchand, col. 4 lines 18-31, col. 5 lines 3-25.

Morchand does not teach or suggest that the selected quadrant can be “repositioned from one of the different portions of the split screen to a position in the one of the menus” as recited in claim 1. Instead, Morchand merely discloses how to manipulate analog control signals which drive a cathode ray tube of a television to blank out a quadrant or a half of the display. See Morchand, col. 4 lines 18-31, col. 5 lines 3-25. The remaining displayed quadrant or half is neither scaled nor repositioned.

Further, like Justice, the manner in which Morchand drives the cathode ray tube could not be applied to reposition a quadrant to a position in a menu as recited in independent claim 1, or as similarly recited in independent claims 8, 22, and 24. The Office Action concedes that Goldstein (with respect to claims 1 and 24), Banker (with respect to claim 22), and Banker combined with Gibson (with respect to claim 8) fail to disclose this feature. Accordingly, claims 1 and 24 are allowable over the combination of Goldstein and Morchand; claim 22 is allowable over the combination of Banker and Morchand; and claim 8 is allowable over the combination of Banker, Gibson, and Morchand.

The Action Fails to Put Forth a Valid Reason to Combine the References

The Action also fails to put forth a prima facie showing of obviousness, because no apparent reason has been shown to combine the references in the manners asserted. Applicant’s claims cannot be shown to be obvious merely by demonstrating that each of the claim elements was independently known. See KSR, 550 U.S. at 418 (2007). The Supreme Court in KSR explained that inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. See *Id.*

The Action asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to modify Goldstein, Banker, and Gibson with either Justice, Morchand, or the combination of Aimonoya and Seager:

... for the typical benefit of more efficiently utilizing bandwidth by allowing a single channel to transmit additional video information by easily combining the elements as claimed using known methods with no change in their respective functions. The combination would have simply required the simple substitution of one known method for another to yield predictable results to one of ordinary skill in the art.

See e.g., Action, page 7. See also Action, pages 4, 10, 13, 17, 23-24, 27, 33, and 36-37)

The Action has put forth no evidence to support this assertion. Aimonoya, Justice, and Morchand, the only cited references which allegedly disclose a split screen, fail to teach or suggests the transmission of a split screen in order to save bandwidth.

Aimonoya fails to disclose the transmission of a split screen altogether, and therefore would not teach or suggest a bandwidth savings. Likewise Justice and Morchand fail to teach or suggest a bandwidth savings in that each display a split screen for the purpose of enabling a pupil to select a correct answer from among four displayed choices. See Justice, Abstract, col. 1 lines 16-42; Morchand, col. 4 lines 18-31, col. 5 lines 3-25. It does not follow that because a split screen is transmitted to a viewer to enable a pupil to view and select one of quadrants of the split screen, that one of skill in the art would be led to transmit multiple video clips in a split screen, and then reposition one of the video clips to a position in a menu in order to save bandwidth as is apparently asserted by the Action. Morchand and Justice simply do not consider or relate to menus and provide no reason or benefit for including their features in a menu of an electronic program guide.

Additionally, as noted before, Morchand and Justice relate to manipulating signals which drive a cathode ray tube. It is not apparent how such cathode ray tube electronics would even be applied to repositioning one video clip of multiple video clips of a split screen into a menu. Thus, the combinations asserted are not a matter of "simple substitution of one known method for another to yield predictable results to one of ordinary skill in the art" as asserted by the Action.

Further to these points, Justice had been published for over twenty five years, and Morchand for over than 35 years, before Applicant's application was filed without anyone, to Applicant's knowledge, applying a split screen channel in the manner alleged, and particularly

not for the purpose of saving bandwidth as asserted by the Action. The Office cannot simply assert that a reason to combine references is “typical” without some support on the record that the benefit was known to those skilled in the art. No support is provided that supports the Office’s “typical benefit” reasons to combine the references in the manners alleged.

It appears that the only reason to combine Justice, Morchand, Aimonoya, or any split screen technique for that matter, with the electronic program guides of Banker and Goldstein results from Applicant’s own disclosure, not from teachings gleaned from the prior art as a whole. Accordingly, the Action’s reasons to combine the references appears to be impermissible hindsight based on Applicant’s own disclosure, and thus, does not support a prima facie showing of obviousness.

Aimonoya, Justice, and Morchand are Non-Analogous art to Goldstein, and Banker

Further, before Aimonoya, Justice, and Morchand could even be combined with Goldstein or Banker, Aimonoya, Justice, and Morchand would have to be analogous art, which requires Aimonoya, Justice, and Morchand to be in the same field of endeavor, or reasonably pertinent to addressing a known need or problem in the field of endeavor. See KSR Intern. Co. v. Teleflex Inc., 550 U.S. 398, 420 (2007); In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant’s claims pertain to generating and presenting menus and electronic program guides. Banker and Goldstein, as well, allegedly disclose electronic program guides, which would apparently have to be constructed prior to being displayed. In contrast, Aimonoya, Justice, Morchand, disclose systems which manipulate the display signals themselves for driving cathode ray tubes to manipulate the displayed image. Further, Justice and Morchand relate to educational television systems for presenting information to students. Applicant respectfully submits that no need or problem known in the field of electronic program guides would have led one of ordinary skill in the art, at the time of Applicant’s filing date, to investigate the field of cathode ray tube electronics or educational television systems for solutions. Accordingly, Aimonoya, Justice, and Morchand are non-analogous to Banker and Goldstein, and cannot be properly applied.

Because the alleged combinations fail to disclose every feature of independent claims 1, 8, 22, and 24, because the Action fails to put forth a valid reason to combine the references, and because the Action attempts to combine non-analogous art, independent claims 1, 2, 22, and 24, and their respective dependent claims are allowable.

Non-Statutory Double Patenting Rejection of Claim 24 Based On U.S. 6,515,680

Claim 1 stands rejected under the non-statutory judicially created doctrine of double patenting over U.S. Pat. No. 6,515,680. Claim 1 has been amended to incorporate the features of claim 25. Applicant submits that the rejection is now moot, and respectfully request the rejection be withdrawn.

Non-Statutory Double Patenting Rejection of Claims 1, 8, 22, and 24-40 Based On U.S. 7,363,645

Claim 1, 8, 22, and 24-36, and 28-40 stand rejected under the non-statutory judicially created doctrine of double patenting over U.S. Pat. No. 7,363,645.²

The Office Action has conceded that the claims are not identical. The Office has the burden of presenting reasons why a person of ordinary skill in the art would conclude that the admitted differences between the claims of the '645 patent and the rejected claims would have been obvious. See MPEP 804(II)(B)(1). The Office Action has not provided any reasons why the claims would have been obvious, and thus has not met its burden.

² The Office Action cites U.S. Patent No. 7,373,645. Since the cited patent is an unrelated patent which is not commonly owned, Applicant assumes the Office Action intended to cite U.S. Patent No. 7,363,645, which was disclosed in Applicant's previous response submitted on August 26, 2009.

CONCLUSION

All issues having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the Examiner is requested to contact the undersigned at (202) 824-3307.

Respectfully submitted,
BANNER & WITCOFF, LTD.

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By: /Michael CuvIELlo/

Michael CuvIELlo
Registration No. 59,255

1100 13th Street, N.W., Suite 1200
Washington, D.C. 20005-4051
(202) 824-3000
(202) 824-3001 (fax)